

REMARKS

Claims 1-10 and 22-24 are pending. The non-elected claims 11-21 have been cancelled.

Specification

The title of the invention has been objected to as being non-descriptive. In response, the title is being amended to specify that the cover is hinged to the memory card. This makes the title more specific to the subject matter being claimed, and is submitted to overcome the basis for the objection.

Claim Rejection Under 35 U.S.C. §102

The rejection of claims 1-6, 8-10 and 22-24 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,890,188 to Le ("Le") is respectfully traversed. Each of the independent claims 1 and 22 of this group specify that the card includes a cover that is rotatable "about an axis extending across a width of the card." The Office Action (p. 3, para. 5, lines 12-16) references Figure 4B of the Le patent and its text at col. 7, lines 1-23 as disclosing this. However, it is respectfully submitted to be clear that the cover 39 of the Le patent is rotatable by a hinge 37 with respect to the card 31 about an axis that extends across a thickness of the card. The Le patent clearly defines its card width W and thickness T in its Figure 2 and text (see col. 4, lines 59-64, for example). The present application uses these terms in the same way (see para. 0029, for example). The hinge axis 61 of the present application disclosure is clearly described as extending across the width of the card (see para. 0037) and is so shown in the figures. The recitation that the cover rotates "about an axis extending across a width of the card," as recited in the independent claims 1 and 22, renders these claims novel over the cited Le patent.

The dependent claims 2-6, 8-10, 23 and 24 are therefore submitted to also be novel and patentable over the cited Le patent. In addition, dependent claim 10 adds a feature of the axis of rotation moving with respect to the memory card as the cover is rotated. This is shown in Figures 3A-3C of the present application, a result of using the double axes hinges 45 and 47. The cited Le patent, on the other hand, discloses a hinge 37 (Figures 4A and 4B) that provides a

an axis of rotation of the cover 39 that is fixed with respect to the card 31. Claim 10 is submitted to be patentable for this additional reason.

Claim Rejections Under 35 U.S.C. §103

The rejection of claim 7 under 35 U.S.C. §103(a) as unpatentable over the cited Le patent is also respectfully traversed. It is clear that the Le patent does not suggest the use of the claimed double axis hinge. The Office Action (p. 7) effectively takes Official Notice of prior art not of record. No reference has been cited to support the allegation that one skilled in the art would have understood that double-axis hinges could be substituted for the single, fixed axis hinge 37 of the Le patent. Rather, it is summarily concluded in the Office Action that this would be the case. It is therefore submitted that no *prima facie* case of the obviousness of claim 7 has been made. Withdrawal of the rejection of claim 7 on this basis is respectfully requested.

Of course, claim 7 is also submitted to be patentable for the same reason given above for its parent claim 1.

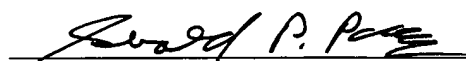
Examiner Telephone Interview Summary

The undersigned attorney appreciates the telephone interview with Examiner Phan that was granted today (July 7, 2006). The rejections of the claims over prior art were discussed and the undersigned made the same points as presented in the remarks above. No agreement was reached. These remarks therefore constitute a summary of what was discussed during the telephone interview.

Conclusion

Accordingly, it is believed that this application is now in condition for allowance and an early indication of its allowance is solicited. However, if the Examiner has any further matters that need to be resolved, a telephone call to the undersigned attorney at 415-318-1163 would be appreciated.

Respectfully submitted,



Gerald P. Parsons
Reg. No. 24,486

July 7, 2006

Date

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PATENT COOPERATION TREATY

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JUN 19 2006

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

PCT Parsons Hsue & de Runtz LLP

To:

PARSONS, Gerald, P.
Parsons, Hsue & de Runtz LLP
595 Market Street
Suite 1900
San Francisco, CA 94105
ETATS-UNIS D'AMERIQUE

NOTIFICATION OF TRANSMITTAL OF THE INTERNATIONAL PRELIMINARY EXAMINATION REPORT (PCT Rule 71.1)

Date of mailing (day/month/year)	12.06.2006
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Applicant's or agent's file reference SNDK.379W00	IMPORTANT NOTIFICATION
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International application No. PCT/US2005/012901	International filing date (day/month/year) 13.04.2005	Priority date (day/month/year) 16.04.2004
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Applicant SANDISK CORPORATION ET AL.

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary examination report and its annexes, if any, established on the international application.
2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.
3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.

4. REMINDER

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices) (Article 39(1)) (see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary examination report. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the PCT Applicant's Guide.

The applicant's attention is drawn to Article 33(5), which provides that the criteria of novelty, inventive step and industrial applicability described in Article 33(2) to (4) merely serve the purposes of international preliminary examination and that "any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed inventions is patentable or not" (see also Article 27(5)). Such additional criteria may relate, for example, to exemptions from patentability, requirements for enabling disclosure, clarity and support for the claims.

Name and mailing address of the international preliminary examining authority:	Authorized Officer
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PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT (PCT Article 36 and Rule 70)

Applicant's or agent's file reference SNDK.379WO0	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/PEA416)	
International application No. PCT/US2005/012901	International filing date (<i>day/month/year</i>) 13.04.2005	Priority date (<i>day/month/year</i>) 16.04.2004
International Patent Classification (IPC) or both national classification and IPC INV. G06K19/077 H01R31/00		
Applicant SANDISK CORPORATION ET AL.		
<p>1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 5 sheets, including this cover sheet.</p> <p><input checked="" type="checkbox"/> This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).</p> <p>These annexes consist of a total of 1 sheets.</p>		
<p>3. This report contains indications relating to the following items:</p> <ul style="list-style-type: none"> I <input checked="" type="checkbox"/> Basis of the opinion II <input type="checkbox"/> Priority III <input type="checkbox"/> Non-establishment of opinion with regard to novelty, inventive step and industrial applicability IV <input type="checkbox"/> Lack of unity of invention V <input checked="" type="checkbox"/> Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement VI <input type="checkbox"/> Certain documents cited VII <input type="checkbox"/> Certain defects in the international application VIII <input type="checkbox"/> Certain observations on the international application 		
Date of submission of the demand 06.12.2005	Date of completion of this report 12.06.2006	
Name and mailing address of the international preliminary examining authority:  European Patent Office - P.B. 5818 Patentlaan 2 NL-2280 HV Rijswijk - Pays Bas Tel. +31 70 340 - 2040 Tx: 31 651 epo nl Fax: +31 70 340 - 3016	Authorized Officer de Ronde, J. Telephone No. +31 70 340-3925 	

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

International application No. **PCT/US2005/012901**

I. Basis of the report

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17)*):

Description, Pages

1-6, 8-12 as originally filed
7 received on 08.12.2005 with letter of 05.12.2005

Claims, Numbers

1-24 as originally filed

Drawings, Sheets

1/2, 2/2 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed; unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
☒ the language of publication of the international application (under Rule 48.3(b)).
☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority in written form.
☐ furnished subsequently to this Authority in computer readable form.
☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
☐ the claims, Nos.:
☐ the drawings, sheets:

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

International application No. **PCT/US2005/012901**

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)

6. Additional observations, if necessary:

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	1-24
	No: Claims	
Inventive step (IS)	Yes: Claims	1-24
	No: Claims	
Industrial applicability (IA)	Yes: Claims	1-24
	No: Claims	

2. Citations and explanations

see separate sheet

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT - SEPARATE SHEET**

International application No. PCT/US2005/012901

Re Item V.

1. Reference is made to the following document:

D1 : US 2004/033727 A1 (KAO CHI-LEI) 19 February 2004 (2004-02-19)

2. Document D1, which is considered to represent the most relevant state of the art, discloses (the references in parentheses applying to this document):

A memory card system, comprising an enclosed circuit card having first and second sets of electrical contacts with different contact patterns positioned apart from each other along a length of the card such that they are adapted to (Article 6 PCT) mate with a respective one of first and second mating receptacles but not the other, at least the first set of contacts being carried by an outside surface of the card, a reprogrammable non-volatile memory that is operably connected to transfer data between the memory and outside of the card with different signal protocols through either of the first or second sets of contacts without the use of the other

From this, the subject-matter of independent claim 1 differs in that:

a cover carried by the card and rotatable by hand between at least first and second positions about an axis extending across the (Article 6 PCT) width of the card, the first set of contacts being covered when the cover is in the first position and exposed for insertion into the first mating receptacle when the cover is in the second position

The subject-matter of claim 1 is therefore novel (Article 33(2) PCT).

The problem to be solved by the present invention may be regarded as:
to protect the first set of contacts when they are not being used.

The solution to this problem proposed in claim 1 of the present application is considered as involving an inventive step (Article 33(3) PCT) for the following reasons:

the idea to solve the above problem using a cover to protect said first set of contacts, said cover being rotatable such that the first set of contacts gets exposed when the cover is rotated away from the contacts to expose them is solved in a different manner, namely, said contacts are retractable in the card body when they are not in use, see e.g. Figures 15 and 16 of D1. Hence, the solution of the application has not been suggested by the prior art D1.

Analagous argumentation is valid for independent claims 11 and 22.

3. Claims 2-10 are dependent on claim 1 and as such also meet the requirements of the PCT with respect to novelty and inventive step.

Claims 12-21 are dependent on claim 11 and as such also meet the requirements of the PCT with respect to novelty and inventive step.

Claims 23, 24 are dependent on claim 22 and as such also meet the requirements of the PCT with respect to novelty and inventive step.

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT - SEPARATE SHEET**

International application No. PCT/US2005/012901

4. Article 6 PCT

- a. In accordance with Rule 6.3(b) PCT the independent claims should be in the two-part form.
- b. The features of the claims are not provided with reference signs placed in parentheses (Rule 6.2(b) PCT).
- c. A document reflecting the prior art D1 is not identified in the description (Rule 5.1(a)(ii) PCT).
- d. Upon entry in certain regional phases, phrases in the description like "incorporated by reference" (paragraph 0019 of the description) and phrases referring to "spirit" and/or "scope" (paragraph 0039 of the description) will have to be excised from the description.
- e. Typographic errors: paragraph 0002,with a host to which the card is connected...
paragraph 0034,memory card is useable....

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08. 12. 2005

(45)

through any of the sets of external contacts alone with the appropriate signal protocol. The standards that are implemented are preferably those that will allow the system to be used directly with a wide variety of host devices having receptacles with various physical and electronic signal protocol and format characteristics.

[0019] Additional aspects, advantages, features and details of the various aspects of the present invention are included in the following description of exemplary examples thereof, which description should be taken in conjunction with the accompanying drawings. All patents, patent applications, articles, manuals, standards, specifications and other publications referenced herein are hereby incorporated herein by those references in their entirety for all purposes.

BRIEF DESCRIPTION OF THE DRAWINGS

[0020] Figures 1A and 1B are perspective views of a memory card having two sets of electrical contacts with a cover of one set of contacts closed (Figure 1A) and with the cover opened (Figure 1B);

[0021] Figures 2A and 2B are plan views of the memory card as shown in Figures 1A and 1B, respectively;

[0022] Figure 3A is a side view of the memory card shown in Figures 1A – 2B with its cover closed, as viewed from position 3A – 3A of Figure 2A;

[0023] Figure 3B is a side view of the memory card shown in Figures 1A – 2B with its cover in a position intermediate of its open and closed positions; and

[0024] Figure 3C is a side view of the memory card shown in Figures 1A – 2B with its cover opened, as viewed from position 3C – 3C of Figure 2B.

DESCRIPTION OF EXEMPLARY EMBODIMENTS

[0025] The example memory card described herein utilizes one set of contacts and a signal protocol from one published memory card standard, such as that for the SD card, and the other set of contacts and a signal protocol according another

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[0022] Figure 3A is a side view of the memory card shown in Figures 1A – 2B with its cover closed, as viewed from position 3A – 3A of Figure 2A;

[0023] Figure 3B is a side view of the memory card shown in Figures 1A – 2B with its cover in a position intermediate of its open and closed positions; and

C

[0024] Figure 3C is a side view of the memory card shown in Figures 1A – 2B with its cover opened, as viewed from position 3C – 3C of Figure 2B.

DESCRIPTION OF EXEMPLARY EMBODIMENTS

[0025] The example memory card described herein utilizes one set of contacts and a signal protocol from one published memory card standard, such as that for the SD card, and the other set of contacts and a signal protocol according another published standard, such as the USB standard or another that provide similar